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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,804	02/27/2002	Ryoheita Hattori	JP920000391US1	8025

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IBM Corporation
Intellectual Property Law
5600 Cottle Road (L2PA/0142)
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EXAMINER

COLON, ROCIO

ART UNIT PAPER NUMBER

2651

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/085,804	Applicant(s) HATTORI ET AL.	
	Examiner Rocio Colon	Art Unit 2651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The word false on page 3, line 21 is referring to the “yes” output in Fig. 4, step 32, the common use of the word “false” is used for “no” and “true” for “yes”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 recites the limitations “said outermost periphery track” and “said track” in lines 10 and 11, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

4. The term “false” in claim 1 is unclear, when referring to Fig. 4, step 32, the use of term “false” is unclear to define if the track is defective or not.
5. The word “recording” on claim 1, line 16, is unclear. The examiner understands that the claim refers to Figure 4, step 35, in that case the word “recording” should be marking.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 3 and 4 rejected under 35 U.S.C. 102(b) as being anticipated by Ukani et al. (USPN 5,870,243).

Regarding claim 3, a rotation recording apparatus, comprising:

a rotary recording medium storing positional information recorded thereon and having concentric tracks formed thereon (Fig. 3, element 108);

a head used for reading/writing said positional information from/on said recording medium (Fig. 3, element 118 and column 4, line 8); and

a device used for controlling the relative position of said head with respect to said recording medium (column 4, lines 16-17),

wherein test pattern data is written on the surface of said recording medium, concretely at an outer periphery portion of said outermost periphery track or the boundary between said track and an adjacent track (Fig. 5, Bursts A and B and column 9, lines 20-21).

Regarding claim 4, Ukani et al. disclose the recording medium is provided with the following items on the surface;

a first pattern written between the center of said track and the center of an adjacent track at the same width as that of said track so as to obtain said positional information (Fig. 5, Burst A);

a second pattern written between the center of said track and the center of an adjacent track at the same width as that of said track in the opposite direction to that of said adjacent track so as to obtain said positional information (Fig. 5, Burst B);

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a third pattern written fully in said track at the same width as that of said track so as to obtain said positional information (Fig. 5, Burst C); and

a fourth pattern written fully in a track adjacent to said track at the same width as that of said track so as to obtain said positional information (Fig. 5, Burst D).

Allowable Subject Matter

6. Claims 1 and 2 would be allowable if rewritten to overcome the claims objections set forth in this Office action.

6. The following is an examiner's statement of reasons for allowance:

The prior art of record taken alone or in combination fail to disclose the steps of controlling the head so as to be positioned at a boundary between an outer periphery portion of the track at the outermost periphery or the track and an adjacent track; recording test pattern data in the outer periphery portion or at the boundary; a first decision step of deciding whether or not the test pattern data is written normally; and marking two tracks adjacent to the outermost periphery track or the boundary as defective tracks if they are not written normally.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rocio Colon whose telephone number is (703) 305-3947. The examiner can normally be reached on Mon-Thu 8:00a.m.-6:30p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703)305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


rcv

August 30, 2004



SINH TRAN
PRIMARY EXAMINER